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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,305	05/26/2000	Anthony A. Shah-Nazaroff	042390.P6484D2	9133

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EXAMINER

MA, JOHNNY

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/580,305	Applicant(s) SHAH-NAZAROFF ET AL.	
	Examiner Johnny Ma	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-16, 18-21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-16, 18-21 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/18/2005 have been fully considered but they are not persuasive.

2. Applicant argues that “it is respectfully asserted that neither Carrubba nor Hjelsvold, either along or in combination, suggests or describes receiving a selection to buy an upgraded media feature for a programming transmission...it is respectfully asserted that Carruba does not teach this limitation...Carrubba instead teaches an upgraded media feature for a program originating on CD-I Player.” The examiner respectfully disagrees, as cited in the previous Office Action, the Carrubba et al. reference discloses:

“[a]n embodiment for a system according to the invention is characterized in that the storage medium containing the basic part is located near the merging means and in that the other storage medium containing the complementary part is linked to the merging means via a transmission line of a communications network. The communications network is, for example, the public telephone network. The storage medium containing the complementary part is located, for example, in a data bank controlled by the provider. The complementary part stored in the databank is accessible to a plurality of users of a system according to the invention via the telephone network” (Carrubba 1:65-67; 2:1-9) wherein CPU controls the transmission of the media upgrade feature (Carrubba 4:21-32).

The claimed “programming transmission” is met by the combination of the complementary and basic part of the audio-visual presentation. The examiner respectfully submits that the transmission of the complementary part of the audio-visual presentation combined with the basic part of the audio-visual presentation results in

programming that is, at least in part, transmitted and thus meets the claimed programming transmission.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 8-15, 18-21, 23, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrubba et al. (US 5,629,866 of record) in further view of Hjelsvold et al. (US 2003/0145333 A1 of record).

As to claim 1, note the Carrubba et al. reference that discloses an audio-visual presentation system. The claimed “receiving a selection to buy an upgraded media feature for a programming transmission” is met by “... a system as defined in the opening paragraph is characterized in that the complementary part is intended for enhancing the quality of the audio-visual presentation that can be achieved with the basic part. In this manner the user has the possibility of enhancing the quality of the audio-visual presentation, such as a video film. The user is first offered by a service provider the basic part of a audio-visual presentation with a lower quality, such as a presentation with a low picture resolution, free of charge or at a reduced rate and may then decide whether he wishes to have the complementary party and thus a more complete version of the audio-visual presentation by paying a considerably higher rate (Carrubba 1:52-64) wherein the system services such requests (Carrubba et al. 4:35-49). The claimed “automatically coordinating provision of the upgraded media feature for the programming transmission”

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is met by “[a]n embodiment for a system according to the invention is characterized in that the storage medium containing the basic part is located near the merging means and in that the other storage medium containing the complementary part is linked to the merging means via a transmission line of a communications network. The communications network is, for example, the public telephone network. The storage medium containing the complementary part is located, for example, in a data bank controlled by the provider. The complementary part stored in the databank is accessible to a plurality of users of a system according to the invention via the telephone network” (Carrubba 1:65-67; 2:1-9) wherein CPU controls the transmission of the media upgrade feature (Carrubba 4:21-32). Furthermore, the Carrubba et al. reference “alludes to the upgraded or ‘complementary’ features costing money.” However, the Carrubba et al. reference is silent as to how the purchase is performed. Now note the Hjelsvold et al. reference that discloses a system for hypervideo filtering based on end-user payment interest and capability relating to providing customers access through a communications network to digital video information stored on a merchant’s server (Hjelsvold [0002]). The claimed “automatically coordinating purchase of the upgraded media feature for the programming transmission” is met by the system providing a user to make spontaneous electronic purchases wherein the requested version is provided upon approval of the electronic payment transaction (Hjelsvold [0014, 0042, 0054, 0055, 0082]) wherein “[f]or payment, wallet 25, commerce server 26, and Secure Electronic Transaction (SET) server 27 are responsible for initiating a payment transaction and exchanging payment information with payment gateway 28 of clearing house 29” (Hjelsvold [0042]) wherein if payment is accepted then the system proceeds to distribution of the paid for level of

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programming (Hjelsvold [0055]). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Carrubba et al. upgrade or complementary features for a fee with the Hjelsvold et al. automatic coordination of upgrade purchases for the purpose of providing the user a quick and convenient means for purchasing the upgraded or complementary features to increase the likelihood of such purchases and to facilitate purchase spontaneity.

As to claim 2, the claimed “wherein the receiving comprises receiving the selection from an entertainment system, and the programming transmission is provided to the entertainment system with the upgraded media feature” is met by the entertainment system of figure 1 and the programming transmission (via the telephone network) which is provided to the entertainment system.

As to claim 8, note the Carrubba et al. reference discloses “...a system as defined in the opening paragraph is characterized in that the complementary part is intended for enhancing the quality of the audio-visual presentation that can be achieved with the basic part. In this manner the user has the possibility of enhancing the quality of the audio-visual presentation, such as a video film. The user is first offered by a service provider a basic part of a audio-visual presentation with a lower quality, such as a presentation with a low picture resolution, free of charge or at a reduced rate and may then decide whether he wishes to have the complementary party and thus a more complete version of the audio-visual presentation by paying a considerably higher rate (Carrubba et al. 1:52-64) wherein the system services such requests (Carrubba et al. 4:35-49). However, the Carrubba et al. reference is silent as to “sending a selection of a server system to buy an

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upgraded media feature for a programming transmission”. Now note the Hjelsvold et al. reference that discloses a system for hypervideo filtering based on end-user payment interest and capability relating to providing customers access through a communications network to digital video information stored on a merchant’s server (Hjelsvold [0002]). The claimed ““sending a selection of a server system to buy an upgraded media feature for a programming transmission” is met by the system providing a user to make spontaneous electronic purchases wherein the requested version is provided upon approval of the electronic payment transaction (Hjelsvold [0014, 0042, 0054, 0055, 0082]) wherein “[f]or payment, wallet 25, commerce server 26, and Secure Electronic Transaction (SET) server 27 are responsible for initiating a payment transaction and exchanging payment information with payment gateway 28 of clearing house 29” (Hjelsvold [0042]) wherein if payment is accepted then the system proceeds to distribution of the paid for level of programming (Hjelsvold [0055]). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Carrubba et al. upgrade or complementary features for a fee with the Hjelsvold et al. automatic coordination of upgrade purchases for the purpose of providing the user a quick and convenient means for purchasing the upgraded or complementary features to increase the likelihood of such purchases and to facilitate purchase spontaneity.

The claimed “receiving a programming transmission with the upgraded media feature” is met by “[a]n embodiment for a system according to the invention is characterized in that the storage medium containing the basic part is located near the merging means and in that the other storage medium containing the complementary part is linked to the merging

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means via a transmission line of a communications network. The communications network is, for example, the public telephone network. The storage medium containing the complementary part is located, for example, in a data bank controlled by the provider. The complementary part stored in the databank is accessible to a plurality of users of a system according to the invention via the telephone network” (Carrubba et al. 1:65-67; 2:1-9) wherein CPU controls the transmission of the media upgrade feature (Carrubba et al. 4:21-32).

As to claims 9-10, note the Carrubba et al. reference discloses billing the client for upgraded media. However, the Carrubba et al. reference does not specifically disclose a charge to a credit account as recited in the claims. Nevertheless, the examiner gives Official Notice that it is well known in the art to receive a bill by charging a credit account at the end of a billing cycle because this is a common accounting/billing technique utilized to easily obtain payment from clients and for services rendered (i.e. the user does not have to mail payment). For example, America Online users, life insurance customers, car insurance customers, electric power users each have the ability to pay for services on a monthly basis by charges posted to their credit accounts. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Carrubba et al. system (if necessary) to include receiving a bill comprising a charge to a credit account because this is a common accounting/billing technique utilized to easily obtain payment from clients for services rendered (i.e. the user does not have to mail payment).

As to claim 11, the claimed “wherein the programming transmission comprises at least one of a movie, a documentary, an audio production, an interactive media event, a

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situation comedy, a news program, and a televised sport event” is met by audio-visual programming discussed throughout the reference including but not limited to column 1, lines 49-64.

As to claim 12, the claimed “wherein the upgraded media feature comprises at least one of a video upgrade, an audio upgrade, a recordable version, and an increased access rate for a interactive event” is met by higher resolution audio-visual programming discussed throughout the reference including by not limited to column 1, lines 59-64 and column 2, lines 28-31.

As to claim 13, the claimed “wherein the programming transmission is received from one of a plurality of programming transmission sources and the plurality of programming transmission sources include at least one of cable television, antenna reception, satellite reception, mini-dish satellite reception, telephone dial-up service, and Internet access” is met by the telephone network programming transmission source as discussed throughout the reference including but not limited to column 2, lines 3-9.

The limitations set forth in apparatus claims 14 and 15 correspond to the limitations in method claims 1 and 2 respectively.

The limitations set forth in apparatus claims 18, 23 and 26 correspond to the limitations in method 8.

As to claims 19-20, please see rejection of claims 9-10.

The limitations set forth in apparatus claim 21 and 25 correspond to the limitations of method 1.

5. Claims 3-6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrubba et al. (US 5,629,866 of record) in further view of Hjelsvold et al. (US

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2003/0145333 A1 of record), Wonfor et al. (US 6,381,747 B1 of record), and Ellis et al. (US 6,357,043 B1 of record).

As to claim 3, the claimed “billing a client for service performed by a server system” is met by the Carrubba et al. and Hjelsvold et al. reference as discussed in the rejection of claim 1. However, the Carrubba et al. and Hjelsvold et al. combination does not specifically teach “providing billing information about the client to at least one of a plurality of programming transmission sources that provided the programming transmission.” Now note the Wonfor et al. reference that discloses a method for controlling copy protection in digital video networks. The Wonfor et al. reference discloses a plurality of programming transmission sources that provided the programming transmission wherein “[a] billing and license fees software subset of the system control software then enables each PPV provider to bill the subscribers and to report and pay the attendant licensing fees to the rights holders [programming transmission sources], etc.” (Wonfor 12:27-46) and billing for such services is performed monthly (Wonfor 11:21-24). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Carrubba et al. and Hjelsvold et al. combination with the Wonfor et al. payment of a plurality of programming transmission sources for the purpose of providing programming from multiple sources in order to provide a greater selection of programming to a user. Although the Carrubba et al., Hjelsvold et al., and Wonfor et al. combination teaches billing for at least one of a plurality of programming transmission sources, the Carrubba et al., Hjelsvold et al., and Wonfor et al. combination does not specifically teach providing billing information about the client to at least one of a plurality of

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programming transmission sources. Now note the Ellis et al. reference that discloses an electronic television program guide with remote product ordering. The claimed “providing billing information about the client” is met by “[u]sing the return channel, orders may be placed and immediately transmitted upstream to the cable headend where they can be processed or forwarded to a separate processing center” (Ellis 36:1-7) wherein order information includes customer billing information (Ellis 34:16-40).

Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Carrubba et al., Hjelsvold et al., and Wonfor et al. combination teaching the ordering of services from a plurality of programming transmission sources with the Ellis et al. forwarding of billing information about the client to a programming transmission source for the purpose of providing an alternate means for providing royalty fees to the programming transmission source wherein the programming transmission source may directly bill the subscriber thus removing any additional administrative burdens/costs associated with a cable headend providing the an intermediate service.

As to claim 4, note the Carrubba et al. reference discloses billing the client for the upgraded media. However, the Carrubba et al. reference does not specifically disclose billing is performed individually for each billing transaction and performed according to a billing cycle as recited in the claims. Nevertheless, the examiner gives Official Notice that it is well known in the art to bill individually for each transaction and to bill according to a billing cycle because these are typical accounting techniques utilized to show clients an itemized list of services rendered for a specified time period. For example: (1) cable television companies provide individual transactions (itemized list) for

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regular programming, pay-per-view programming, equipment charges, taxes etc. for a monthly period; and (2) telephone companies list transactions (itemized list) for local calls, long distance class, line charges, special feature charges and taxes for a monthly period. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Carrubba et al. system (if necessary) to include billing to be performed individually for each billing transaction and billing to be performed according to a billing cycle because there are typical accounting techniques utilized to show clients an itemized list of services rendered for a specified time period.

As to claim 5, please see rejection of claim 3 wherein billing is performed on a monthly basis.

As to claim 6, please see rejection of claim 4.

As to claim 16, please see rejection of claim 5.

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carrubba et al. (US 5,629,866 of record) in further view of Hjelsvold et al. (US 2003/0145333 A1 of record) and Hendricks et al. (US 5,990,927 of record).

As to claim 24, note the Carrubba et al. reference discloses an entertainment system (figure 1) to display the programming transmission with the upgraded media feature (columns 102). However, the Carrubba et al. reference is silent as to a user interface to provide a plurality of selection options to a user, wherein said user interface receives the selection from the user as recited in the claim. Now note the Hendricks et al. reference, that discloses a communication system comprising a user interface to provide a plurality of selection options to a user and wherein the user interface receives the

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selection from the user for the advantage of providing the user with a menu of options to make desired program selections (Hendricks et al., columns 12-13, figures 1-15 and 21-23). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Carrubba et al. system (if necessary) to include a user interface to provide a plurality of selection options to a user and wherein the user interface receives the selection from the user, as taught by Hendricks et al., for the purpose/advantage of providing the user with a menu of options to facilitate the making of desired program selections.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (571) 272-7351. The examiner can normally be reached on 8:00 am - 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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